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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,863

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Ziv Neeman

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NATIONAL INSTITUTES OF HEALTH  
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EXAMINER

MENDOZA, MICHAEL G

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

11/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,863	<b>Applicant(s)</b> NEEMAN ET AL.	
	<b>Examiner</b> MICHAEL G. MENDOZA	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 14 is/are allowed.
- 6) ☒ Claim(s) 8-11, 13 and 15-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see pgs 5-6 of the arguments, filed 1/7/2009, with respect to claims 1-7 and 14 have been fully considered and are persuasive. The rejections of claims 1-7 have been withdrawn.
2. Applicant's arguments with respect to claims 8-11, 13, and 15-19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-11, 13, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connell in view of Yadav et al. 6391044
5. O'Connell teaches a venous filter comprising a web (703) comprising a dissolvable material; and at least two anchors (702 + 708), wherein said at least two anchors are configured to retain said web within a mammalian blood vessel (see fig. 29); wherein the dissolvable material comprises polyglycolic acid; wherein the filter dissolves in stages based upon the chemical solubility of the web components (col. 14, lines 7-21); wherein the filter dissolves in stages, the filter dissolution starting at the filter center and concluding at the filter periphery (O'Connell teach that the retainer dissolves first (center) then the filter (periphery) dissolves at a slower rate, col. 14, lines

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7-21); wherein the filter has a shape selected from the group consisting of a web, a spiral, and a conical shape.

6. It should be noted that O'Connell fails to teach wherein the dissolvable material comprises one piece of material that is spiraled. O'Connell teaches dissolvable struts with a web.

7. Yadav et al. teaches a common filter with strut and a web. Yadav et al. also teaches an alternative to struts and a web being a spiral with a web (see fig. 10).

Therefore it would have been to one having ordinary skill in the art at the time the invention was made to modify the filter of O'Connell to include the spiral in view of Yadav et al. as an alternative to struts of O'Connell.

8. O'Connell/Yadav teaches the venous filter of claim 12, further comprising other pieces of dissolvable material (110) that crosslinks the spiraled piece of dissolvable material (see fig. 10, Yadav).

9. As to claims 10 and 11, O'Connell/Yadav teaches the claimed invention except for the claimed dissolvable material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the any of the claimed materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connell in view of Yadav et al. as applied to claim 8 above, and further in view of WasDyke 6972025.

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11. O'Connell/Yadav teaches the venous filter of claim 8. It should be noted that O'Connell/Yadav fails to teach wherein the filter dissolves in stages based on thickness. O'Connell/Yadav teaches that the filter dissolves in stages to different materials.

12. WasDyke teaches a venous filter of a bioabsorbable material wherein the support members thickness can be altered to impart particular characteristics (col. 4, lines 39-42). It is known that a thinner section of bioabsorbably material would bioabsorb more quickly than a thicker piece. Therefore, it would have been obvious to modify the filter of O'Connell/Yadav to have varied thickness in view of WasDyke to come to same staged results as using different materials having different dissolving rates.

***Allowable Subject Matter***

13. Claims 1-7 and 14 are allowable over the prior art of record.

14. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or render obvious the overall claimed inventions of a venous filter comprising a strut portion and an anchor portion fit together via a positive and a negative thread, and wherein the thread on either of the strut portion, said anchor portion, or both comprises an electrolytically active thread that erodes quickly, wherein the strut portion can be separated from the anchor portion at least in part by the application of an electrical current; or strut portion, a temperature sensitive portion and an anchor portion, wherein the temperature sensitive portion is comprised of a temperature sensitive material different from the anchor portion, and wherein the material is located between the strut portion and the anchor portion and provides for separation of the anchor portion from the temperature sensitive portion

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upon removal of the venous filter at least in part by changing the temperature around at least the temperature sensitive portion.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL G. MENDOZA whose telephone number is (571)272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. G. M./  
Examiner, Art Unit 3734

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3734